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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,970	02/14/2002	Michael Helmus	01-202	9278

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EXAMINER	
TYSON, MELANIE RUANO	
ART UNIT	**PAPER NUMBER**
3773	
MAIL DATE	**DELIVERY MODE**
12/19/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/075,970	HELMUS, MICHAEL	
	Examiner	Art Unit	
	Melanie Tyson	3773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 September 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3,5-7,9-21 and 46-50* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3,5-7,9-21 and 46-50* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This action is in response to the applicant's amendment received on 23 September 2008. Claims 2, 4, 8, and 22-45 remain cancelled. New claims 49 and 50 have been added.

Response to Arguments

Applicant's arguments with respect to claims 1, 3, 5-7, 9-21, and 46-48 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 3, 5-7, 9-21, and 46-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clerc (U.S. Publication No. 2002/0165601 A1) in view of Boltz (U.S. Patent No. 6,287,332 B1). Clerc discloses an implantable medical device (see entire document) comprising a biodegradable inner core (stent 102), thus becoming

decreasingly rigid upon contact with bodily fluid, and a biodegradable covering material (106) completely covering the inner core (for example, see Fig. 2A) and does not contain a therapeutic agent therein (an alternate embodiment may if desired), wherein the entire medical device is substantially biodegradable by the body (for example, see paragraph 14). The covering material is formed of a hydrophobic surface erodable polymer (for example, polycaprolactone; see paragraph 27), thus is capable of controlling the rate at which the inner core material becomes flexible upon contact with bodily fluids. Clerc fails to disclose the biodegradable inner core material is selected from a metallic material and a ceramic material.

Boltz discloses an implantable medical device, such as a bioresorbable stent (see entire document). Bolz teaches constructing the bioresorbable stent of degradable metallic materials. Bolz further teaches that stents of degradable metallic material combine the advantageous mechanical properties of metal stents (such as elasticity, deformability, and stability by way of improving ductility, tensile strength, etc.; for example, see column 3, lines 11-35) with the bioresorbability of polymer-based stents (for example, see column 2, lines 6-16). It is well within the general knowledge of one having ordinary skill in the art to use a known technique to improve similar devices in the same way. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form Clerc's inner core from a biodegradable metallic material as taught by Bolz. Doing so would provide the mechanical advantages described above.

With further respect to claims 7, 10, and 48-50, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the inner core and covering from the materials recited, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

With further respect to claims 11-14, Clerc discloses the inner core material comprises a braided structure. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to construct the inner core comprising the structures recited in claims 11 and 14, since the applicant has not disclosed that such structures provide an advantage, are used for a particular purpose, or solve a stated problem and it appears the invention would perform equally well with braided filaments.

Claim 15 is being treated as a product by process limitation, in that "the tubular structure is micromachined or laser-cut" refers to the process of forming the tubular structure and not to the final product created. As set forth in MPEP 2113, "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product in the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695,698,227 USPQ 964,966 (Fed. Cir. 1985). Examiner has evaluated the product claim without giving much weight to the method of its manufacture. Therefore, in this case, a stent as described above wherein the tubular body is formed by micromachining

or laser-cutting is directed to the method of making the stent and not to the final product made. It appears that the product disclosed by Clerc in view of Boltz would be the same as that claimed; especially since both applicant's product and the prior art product have the same final structure of a biodegradable inner core material and a biodegradable covering material.

With further respect to claims 16-18, it is well known in the art to coat medical devices with one or more coatings containing therapeutic agents therein. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to coat the Clerc in view of Boltz device with one or more coatings containing one or more therapeutic agents therein in applications that require such treatment.

With further respect to claims 19-21, the Clerc in view of Boltz stent is capable of being used as claimed if one so desires.

With further respect to claims 46 and 47, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the stent to have adequate rigidity from about three to about six months and that is completely biodegradable within about six months to one year following implantation, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie Tyson whose telephone number is (571)272-9062. The examiner can normally be reached on Monday through Thursday 8:30-7 (max flex).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Melanie Tyson /M. T./
Examiner, Art Unit 3773
December 14, 2008

/(Jackie) Tan-Uyen T. Ho/
Supervisory Patent Examiner, Art Unit 3773